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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/056,073	01/28/2002	Yoshinobu Kaneko	1419.1059	3620
21171	7590	12/22/2003	EXAMINER	
STAAS & HALSEY LLP SUITE 700 1201 NEW YORK AVENUE, N.W. WASHINGTON, DC 20005				WILLIAMS, JAMILA O
		ART UNIT		PAPER NUMBER
		3712		

DATE MAILED: 12/22/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.	10/056,073	Applicant(s)	KANEKO ET AL.
Examiner	Jamila O Williams	Art Unit	3712

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

1) Responsive to communication(s) filed on preliminary amendment filed 5/13/03.

2a) This action is **FINAL**.      2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

4) Claim(s) 1-34 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) Claim(s) 1-31 is/are allowed.

6) Claim(s) 32-34 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. §§ 119 and 120

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some \* c) None of:

    1. Certified copies of the priority documents have been received.

    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.

    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

13) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

a) The translation of the foreign language provisional application has been received.

14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

### Attachment(s)

1) Notice of References Cited (PTO-892)

2) Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) Information Disclosure Statement(s) (PTO-1449) Paper No(s) 6,9.

4) Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.

5) Notice of Informal Patent Application (PTO-152)

6) Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Specification***

1. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: the phrase “motor clip”, as recited in claims 33-34 does not have proper antecedent basis.

### ***Claim Objections***

2. Claim 33 objected to because of the following informalities: There is a lack of antecedent basis for the limitation “the base body” in line 4 of the claim. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 32-33 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The use of the limitation “serving as a heat sink” constitutes new matter in that the specification does not provide adequate

support for the limitation. The examiner notes that the applicant has disclosed that the motor attachment plate serves as a radiation plate (page 5 paragraphs [0012-0013]), but to one of ordinary skill in the mechanical art this does not provide support for a heat sink (i.e. heat sinks usually have fins, which does not seem to be the case in this application).

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 32-33 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The phase "attachable to/detachable from" is indefinite. It is unclear what conditions are intended to be encompassed by the punctuation used.

***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 32 and 34 are rejected under 35 U.S.C. 102(b) as being anticipated by '571 to Dicke. Dicke discloses a motor attachment plate or motor clip (77) hooking on one side to a hinge means (78, is interpreted to be a shaft type hinge connection since the specification column 4 lines 29-31 cites that in the alternative the hinge

may be a molded piece instead of a “non molded” piece leading one of ordinary skill in the art to believe that 78 is some type of shaft type hinge, fig 4) attached to a base body (70) to rotate into open and closed positions, attachable to/ detachable from the base on the opposing side (hook 87). Regarding the limitations of the preamble (reciting an attachment structure of a motor of a toy), it has been held that a preamble is denied the effect of a limitation where the claim is drawn to a structure and the portion of the claim following the preamble is a self-contained description of the structure not depending for completeness upon the introductory clause. *Kropa v Robie*, 88 USPQ 478 (CCPA 1951). In addition there is not structural limitation of the “toy” which differentiates it from the device of Dicke. Regarding the limitation “serving as a heat sink”, see new matter rejection above.

### ***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:
  - (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.
9. Claims 32-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over '812 to Dipnall or '013 to Fujitani (both of ids filed 10-18-02) in view of '921 to Klint et al. Dipnall and Fujitani both disclose motor attachment plates or clips (20 and 3 respectively) having a snap type connection that is attachable to/detachable from the

base. These references do not however provide a teaching for a shaft type hinge connection. It is well known to have covers with hinge type connection as shown by Clint (see figure 3-4, the hinge 23) in the toy art. It would have been obvious to one having ordinary skill in the art at the time the invention was made to use the shaft type hinge connection in of Clint with the cover of Dipnall or Fujitani for the purpose of providing easier access. This combination further provides the shaft of the motor and the shaft of the motor clip to be approximately parallel, as recited in claim 33.

10. Claims 32 and 34 are rejected under 35 U.S.C. 103(a) as being unpatentable over '485 to Jolley (ids filed 10-18-02) in view of Official Notice. Jolley discloses a motor attachment plate or clip (42) that is attached to the base of the toy and rotates in open and closed positions (via hinges figure 6) and being attachable to/detachable from the base body on an opposing side (hood in closed position latches with 48). Jolley does not however disclose the use of a shaft type hinge connection. It would have been obvious to one having ordinary skill in the art at the time the invention was made to use a shaft type hinge connection since the examiner takes Official Notice of the equivalence of the hook type hinge connection used in Jolley (fig 6) and shaft type hinge connections for their use in the toy art. Selection of any of these known equivalents would be within the level of ordinary skill in the art.

#### ***Allowable Subject Matter***

11. Claims 1-31 are allowed.

***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. This is simply art of interest and was not used to reject any claims in this office action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jamila O Williams whose telephone number is 703-305-3312. The examiner can normally be reached on 6:30am-3:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Derris H Banks can be reached on 703-308-1745. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1148.



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JW